

I. Remarks

After entry of the amendment, claims 2-59 are pending.

The Related Applications section has been updated.

In order to comply with the restriction requirement, claim 1 has been cancelled, without prejudice, and replaced by claim 59, which is supported by original claim 1 and the specification at, for example, page 39, line 18 to page 42, line 23. Claim 59 is directed to elected Group II.

The dependency of claims 2, 28 and 51 have been amended.

On page 3 of the Office Action, the Examiner states that Applicants failed to define substitutes R⁴ and R⁵ for the compounds of Formula (II). Applicants respectfully submit that these substituents are defined in the specification at page 29, line 27 to page 32, line 27; and page 130, line 25 to page 133, line 25.

No issues of new matter should arise and entry of the amendment is respectfully requested.

II. Restriction Requirement

In response to the Restriction Requirement of November 19, 2004, Applicants elected Group II, with traverse. In the Office Action dated February 18, 2005, the Examiner made the restriction requirement final. The Examiner then only searched and examined the elected species, and declined to extend the search beyond the elected species to encompass other compounds falling within the scope of Group II. In view thereof, Applicants are filing concurrently herewith a Petition from Requirement for Restriction Under 37 C.F.R. § 1.144.

Applicants respectfully request that the enclosed Petition be forwarded to the Group Director for timely consideration.

III. Rejection under 35 U.S.C. §112, First Paragraph

Claims 1, 2 14-16, 28-39 and 55-57 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

Applicants respectfully traverse the rejection and submit that the substituents R¹, R^{1'}, R², R⁴ and R⁵ are defined in the specification at, for example, page 22, line 28 to page 39, line 8; and page 123, line 26 to page 140, line 3. In view thereof, Applicants respectfully submit that the

claims satisfy the requirement under 35 U.S.C. § 112, first paragraph, and respectfully request that the rejection under this provision be withdrawn.

IV. Rejection under 35 U.S.C. §112, Second Paragraph

Claims 1, 2 14-16, 28-39 and 55-57 are rejected under 35 USC § 112, second paragraph, as being indefinite.

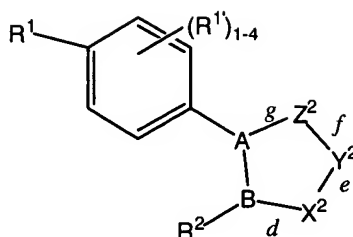
Applicants respectfully submit that the substituents R¹, R^{1'}, R², R⁴ and R⁵ are defined in the specification at, for example, page 22, line 28 to page 39, line 8; and page 123, line 26 to page 140, line 3. In view thereof, Applicants respectfully submit that the claims satisfy the requirement under 35 U.S.C. § 112, second paragraph, and respectfully request that the rejection under this provision be withdrawn.

V. Objection

Claims 1, 2 14-16, 28-39 and 55-57 are objected to for containing non-elected species.

Applicants respectfully traverse the objection and respectfully submit that the pending claims are all directed to the compounds of Formula (II) and fully comply with the Examiner's Restriction Requirement dated November 16, 2004. In response to the restriction requirement Applicants elected Group II, with traverse, drawn to the compounds of Formula (II) and compositions thereof. The Examiner now contends that he is only required to search and examine the elected species and that he is not required to extend the search to encompass the compounds of Group II.

MPEP § 803.02 states that compounds within a proper Markush-type group must (i) share a common utility and (ii) share a substantial structural feature. Claims 1, 2 14-16, 28-39 and 55-57 for the compounds of Formula (II) are all encompassed within a proper Markush-type group. The compounds of Formula (II) (as shown below), are all COX-2 inhibitors and all share a common novel core, that must contain at least one oxime group and/or hydrazone group:



:II

In view thereof, Applicants respectfully submit that the claims should not be restricted solely to the elected species and respectfully request that the objection under this provision be withdrawn.

To further prosecution on this matter, Applicants are filing concurrently herewith a Petition from Requirement for Restriction Under 37 C.F.R. § 1.144, and respectfully request that this Petition be forward to the Group Director for, *inter alia*, resolution of this objection.

VI. Rejoinder of claims

Applicants thank the Examiner for the rejoinder of claim 40-50. Applicants would like to direct the Examiner's attention to U.S. Patent Nos. 5,474,995, 6,649,629 and WO 01/81332 which is provided in the Information Disclosure Statement filed herewith. These patents disclose various methods of use for selective cyclooxygenase-2 inhibitors.

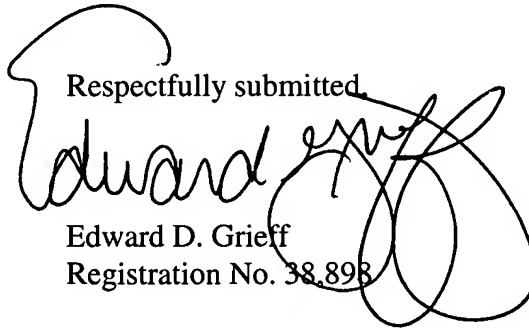
Applicants respectfully request the rejoinder and examination of method claims 3-13 and 17-27. These claims are directed to the methods of use for the compounds of Formula (II) and are the same methods of use disclosed in claims 40-50 for the compounds of Formula (II) in combination with at least one nitric oxide donor compound and/or at least one therapeutic agent. The prior art search for the methods of use for claims 40-50 will be the same prior art for the methods of use for claims 3-13 and 17-27. Hence, the rejoinder and examination of claims 3-13 and 17-27 would not place an additional burden on the Examiner. Also if the methods of use for the compounds o Formula (II) in combination with at least one nitric oxide donor compound and/or at least one therapeutic agent are allowable then the same methods of use for the compounds of Formula (II) alone must also be allowable.

In view of the above, Applicants respectfully submit that it would not place an undue burden on the Examiner to rejoin and examine pending claims 3-13 and 17-27 in view of the fact Examiner is willing to rejoin claims 40-50..

VII. Conclusion

Applicants respectfully request reconsideration and allowance of claims 2-59. Examiner Solola is encouraged to contact the undersigned at 202-942-8453 concerning any questions about the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edward D. Grieff", is written over the typed name and registration number. The signature is stylized with large loops and a long horizontal stroke.

Edward D. Grieff
Registration No. 38,898

Date: May 18, 2005
WILMER CUTLER PICKERING
HALE AND DORR LLP
1455 Pennsylvania Avenue, NW
Washington, DC 20004
Phone: (202) 942-8453